

REMARKS

In the Office Action, the Examiner rejected claims 1-6. Applicants canceled claims 7-26 in a previous communication. By the present Response, Applicants amend claims 1-3 and 6 to further clarify the claimed subject matter and add new claims 27-30. Applicants respectfully note that claims 27-30 include the same subject matter previously presented in canceled claims 23-26 and, as discussed in the previous Response, are believed to belong to the same group as claims 1-6 ("Group III"), which Applicants previously elected. Upon entry of the amendments, claims 1-6 and 27-30 will be pending in the present patent application. Applicants respectfully request reconsideration of the above-referenced application in view of the foregoing amendments and following remarks.

Rejections Under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claim 3 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. As indicated above, Applicants have amended claims 1 and 3 to correct this informality. In light of these amendments, Applicants respectfully request withdrawal of the rejection of claim 3 under 35 U.S.C. § 112.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-6 under 35 U.S.C. § 102(e) as anticipated by Ward et al. (U.S. Patent No. 6,318,898). Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the

claimed invention must be identically shown in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

Omitted Features of Independent Claim 1

Turning now to the present claims, the Ward et al. reference fails to disclose each element of independent claim 1. For instance, independent claim 1 recites “an outer electrolytic nickel layer disposed *over* the electroless nickel alloy layer” (emphasis added). Because the Ward et al. reference fails to disclose such an element, the cited reference fails to anticipate independent claim 1.

As a preliminary matter, Applicants respectfully disagree with the Examiner’s blanket categorization of “electrolytic” and “electroless,” as recited in the claims, as product-by-process limitations. See Office Action mailed April 5, 2005, page 3. As would be appreciated by one skilled in the art, while these two processes can both be used for plating, the resulting metal plates from these processes generally have different physical characteristics, such as the uniformity, hardness, and corrosion resistance of a particular plate. For the Examiner’s convenience, Applicants have enclosed a copy of a manufacturing process fact sheet that briefly discusses various differences, including physical differences, between electroplating and electroless plating. Because “electrolytic” and “electroless” denote not only the process by which the layers are formed, but also *physical* differences between the layers, Applicants request that the Examiner accord these terms their proper patentable weight upon reconsideration of the present rejection.

In the Office Action, the Examiner provided only a conclusory statement alleging that the Ward et al. reference contains the presently claimed subject matter. *See* Office Action mailed April 5, 2005, page 3. Further, this allegation appears to be based solely on similarities between FIG. 4 of the Ward et al. reference and FIG. 4 of the present application. *See id.* However, Applicants respectfully note that the Ward et al. reference discloses an electrolytic nickel layer 67 applied to a substrate 66, and an autocatalytic nickel-phosphorous alloy layer 68 deposited over nickel layer 67. Col. 4, lines 48-53. The cited reference also discloses applying a conversion coating 70 over the alloy layer 68 and, in turn, applying a top coat 72 of polytetrafluoroethylene (PTFE) over the conversion coating 70. Col. 5, lines 7-22. In other words, the Ward et al. reference teaches a nickel alloy layer 68 disposed over an electrolytic nickel layer and additional non-metallic layers disposed over the nickel layer alloy.

Conversely, independent claim 1 of the present application recites “an outer electrolytic nickel layer disposed over the electroless nickel alloy layer.” Applicants respectfully submit the Ward et al. reference teaches, at most, an electrolytic nickel layer disposed *under* a nickel alloy layer. Further, it is evident that neither the conversion coating 70 nor the top coat 72 is a nickel layer, let alone “an electrolytic nickel layer.” The Ward et al. reference, therefore, does not in any way disclose, or even suggest, “an outer electrolytic nickel layer disposed over the electroless nickel alloy layer.” Consequently, Applicants respectfully assert that the Ward et al. reference cannot support a *prima facie* case of anticipation with respect to independent claim 1 or its dependent claims. Accordingly, Applicants respectfully request withdrawal of the present rejection and allowance of claims 1-6.

New Claims

New claims 27-30 have been added by this Response. These new claims add no new matter and are fully supported throughout the specification. Furthermore, in view of the earlier cancellation of claims 7-26, which included three independent claims, no fees

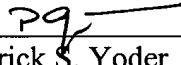
are believed due for the addition of claims 27-30 in this Response. For reasons including those provided above with respect to independent claim 1, claims 27-30 are patentable over the cited reference and are believed to be in condition for allowance. Accordingly, Applicants respectfully request allowance of claims 27-30.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: July 5, 2005



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